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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,078	06/21/2002	Norbert Albrecht	ALBR3001/JEK	5670

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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10/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/030,078

Applicant(s)

ALBRECHT ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-23-07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-13 and 15-25 have been examined.

Response to Amendments/Arguments

2. The Examiner recommends that Applicant consider the claim language discussed during the interview dated June 21, 2007.

Claims 1, 9, 19, and 21 recite conditional or optional limitations (e.g. "if", "when", "upon"). For example, claim 19 recites including an indication that a terminal requires data to perform a transaction if the terminal lacks such a capability (i.e. "making a determination whether the terminal is configured to perform the transaction" and "based on said determination *whether* the terminal requires data...") (emphasis added) but is silent as to what is included in the start sequence if the terminal does not require the data. It has been held that language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C; Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991); In re Collier, 158 USPQ 266 (CCPA 1968); In re Johnston, 77 USPQ2d 1788 (CA FC 2006)) therefore limitations directed to how the terminals are configured or the occurrence of a

predetermined event will not differentiate the claims from the prior art. In general, Applicant's claims recite functional or intended use language and non-functional descriptive material. For example, claim 1 (system) recites "configured", claim 10 (terminal) recites "wherein the terminal requests", claim 21 (method) recites "such that", while claims 1 (system) and 12 (terminal) recite "the start sequence comprising card data..." and "contains information", respectively. It has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). It has also been held that a recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus (*In re Rishoi*, 94 USPQ 71 (CCPA 1952); *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II). Nonetheless, as Daly et al. teach a user transmitting a start sequence comprising information from a portable data carrier as well as transaction information ('141, column 7, lines 1-7; column 9, lines 2-7) and Southgate teaches transmitting a start sequence to the node computer that comprises the type of terminal and the type of error (e.g. temporary results or necessary files for troubleshooting the error) for requesting data that enables the terminal to fulfill the request ('579, column/line 5/60-6/13;

column 9, lines 19-39), the combined prior art at least suggests providing to a remote device whatever information the remote device can use in order to identify the software required to fix a problem at a terminal ('579, (abstract; column 3, lines 29-44; column 4, lines 28-47 and 60-67; column 6, lines 27-67; column 7, lines 1-8 and 22-35; column/line 8/32-9/15).

The Examiner is maintaining the 112 rejection to claims 1 and 9 as the scope (i.e. configuration) of the claimed terminal is unclear.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 and 15-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 1 and 9 are directed to structure but recite limitations in terms of possibility. It has been held that actions that may or may not be done is indefinite and does not distinguish the claim from the prior art (*In re Collier*, 158 USPQ 266 (CCPA 1968); *In re Venezia*, 189 USPQ 149 (C.C.P.A. 1976)) therefore claims 1, 3-7 and 9 are rejected under 112 second paragraph.

Claims 2-8, 10-13, 15-18, 22 and 23 are also rejected as each depends from claim 1, 3-7 or 9.

b) Claim 1 recites "the start sequence comprising data read from the portable data carrier". However, claim 1 is directed to a system and a portable data carrier is not part of the system. Nor is information from the portable data carrier ever accessed (see *IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

Therefore, the scope and operation of the claimed system is unclear to one of ordinary skill (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

c) Claims 1, 9, 19, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: inserting a portable data carrier into a terminal, reading data stored on said portable data carrier.

Claims 2-8, 10-13, 15-18, 20, and 22-25 are also rejected as each depends from either claim 1, 9, 19 or 21.

d) Claim 6 recites "at least one central processing unit and the latter is includable in a transaction" (wherein "latter" is interpreted as the central processing unit). However, to one of ordinary skill a transaction comprises data such as price, item to be purchased, credit card number, buyer ID and seller ID, therefore it is not clear to one of ordinary skill how a central processing unit would comprise data in a transaction (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

e) Claim 19 recites the limitation "the type of transaction" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claims 20 and 24 are also rejected as each depends from claim 19.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-13 and 15-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly et al., U.S. Patent No. 5,878,141 in view of Southgate, U.S. Patent No. 6,205,579.

As per claims 1-7, 9-11,13 and 15-25, Daly et al. teach:

- a node computer is connected with a plurality of terminals (figure 1) wherein the computer stores data and can call data from a central processing unit
- terminals for accessing a portable data carrier to complete a transaction (i.e. elements of the terminal's processor unit are formed partly on the portable data carrier) (column/line 8/62-9/8)
- completing a transaction between the terminal and the node computer (figure 1; column 6, lines 37-67)
- a transaction is performed with the node and the terminal each performing partial steps of the transaction (abstract; figures 2 and 5-7)
- a terminal comprising a processor, storage, network interface with node computer, means for triggering a transaction (e.g. keyboard and display) and apparatus for reading a portable data carrier (figures 1 and 5; column 6, lines 37-67; column 7, lines 33-40)

Daly et al. do not specifically recite a terminal making a determination whether it is capable to perform a transaction and if not retrieving from a host computer

data for enabling the performance of said transaction. Southgate discloses a software update system wherein a terminal makes a determination that the terminal is not suitable to perform a request and as a result contacts a node computer in order to obtain data (i.e. cause transfer or transmission of data following the occurrence of a condition) to enable the terminal to fulfill the request wherein the terminal stores the data for future use (abstract; column 3, lines 29-44; column 4, lines 28-47 and 60-67; column 6, lines 27-67; column 7, lines 1-8 and 22-35; column/line 8/32-9/15). Southgate also teaches a terminal transmitting a start sequence to the node computer that comprises the type of terminal and the type of error (e.g. temporary results or necessary files for troubleshooting the error) for requesting data that enables the terminal to fulfill the request (column/line 5/60-6/13; column 9, lines 19-39). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Daly et al. and Southgate in order to correct errors ('579, column/line 8/32-9/15) in the client system ('141, figure 1; column 7, lines 25-40) that prevent a user from completing a transaction ('141, column 7, lines 25-40; column/line 8/62-9/8).

As per claims 8 and 12, Daly et al. teach securing terminal and node communications using public key cryptography with key exchange (column/line 14/10-16/33). A well-known device for affecting cryptographic communications is a box (e.g. encryption/decryption box, chip).

As per claim 19, it has been held that language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C; Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991); In re Collier, 158 USPQ 266 (CCPA 1968); In re Johnston, 77 USPQ2d 1788 (CA FC 2006)). Therefore, as Daly et al. teach sending information stored on a portable data carrier and transaction information (column 7, lines 1-7; column 9, lines 2-9) it is sufficient in terms of art.

Conclusion

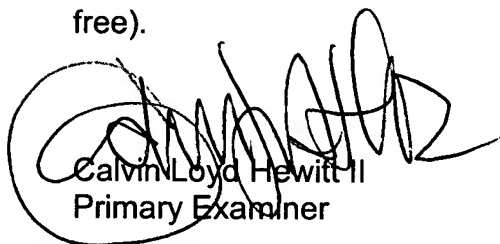
8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

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Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Calvin Lloyd Hewitt II
Primary Examiner

October 10, 2007